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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,389	02/02/2000	Boris V. Marchegiani	11305/1	6138
26646	7590	11/30/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/496,389	<b>Applicant(s)</b> MARCHEGIANI, BORIS V.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-6,8-11,15-17,19-24,26,28,29 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8-11,15-17,19-24,26,28,29 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 4-6, 8-11, 16, 17, 19-24, 26, 28, 29, and 35 are pending in this communication filed 7/19/04 as Appeal Brief and Extension of Time.
2. In view of the Appeal Brief and arguments filed on 7/19/04, the finality of the office action is withdrawn and PROSECUTION IS HEREBY REOPENED. As set forth here below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Specification***

3. The amended abstract of the disclosure is objected to for minor informalities because the Specification recites "A tender" as defined herein, is the initial provision of an offer for a purchase or sale of commodity for use in an auction, ...". The Specification would be better read as "A tender" as defined herein, is the initial provision of an offer for a purchase or sale of a commodity for use in an auction, ...". Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9, 10, 23, and 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 line 2 reads "device at least one of transmits and receives the information". It is very unclear what Applicant means by "device at least one of transmits and receives". Does Applicant mean the processing device transmits and receives the information"? Claims 10, 23, and 24 have a similar problem.

Claims 1, 5, 11, 17, 20, 26, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 5, 11, 17, 20, 26, and 35 refer to a "tender". It is unclear from the claim language what Applicant means by a "tender". Does Applicant mean an "auction" or a "bid" or a "commodity"? It is acknowledged Applicant can be his own lexicographer. However, the Examiner must be able to understand from the claim language what Applicant means by the term "tender". Clarification in the claim language and to the Examiner is respectfully requested.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 4, 11, 17, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over (WO 99/05629) Bergato.

As per claims 1, 11, 17, 26, and 35, Bergato teaches, a system for utilizing at least one tender, comprising: a storage device storing data which relates to the at least one tender (Page 4, lines 7-28) and a processing device transmitting information corresponding to the data and wherein the complex multi-variable commodity is a particular commodity whose price determination is based on a variation of a plurality of variable characteristics regarding a physical characteristic of the particular commodity (page 4, line 22 –page 6, line 14 – bidding (auction)). Bergato did not expressly disclose, a “tender”. A “tender” by definition is to offer for payment of an obligation; an offer of money, services, etc. made to satisfy an obligation. Something offered in payment, especially money; to submit as a tender (to tender a bid); a bid stating terms of a contract or a bid on a printed form submitted to buy securities at a certain price.

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As per claim 11, Bergato teaches, A method for utilizing at least one tender, comprising the steps of receiving data for the at least one tender, the at least one tender being provided for a complex multi-variable commodity; and transmitting information corresponding to the data to a device (page 4, line 22-page 6, line 14 and page 19, lines 10-27).

As per claim 17, Bergato further teaches, A system for utilizing at least one tender, comprising: wherein the at least one tender includes at least one of a term and a condition and wherein the term and the condition are capable of being modified (page 4, line 7-page 7, line 18, page 8, line 11-page 9, line 27, and page 28, lines 6-28).

As per independent claim 35 this independent claim reciting "A set of instructions residing in a storage medium, the set of instructions capable of being executed by a processor to implement a method for utilizing at least one tender" is rejected for the similar rationale as given for claims 11 and 26 because the method steps of claim 35 correspond to the steps of claims 11 and 26.

As per claim 4, Bergato teaches, the system according to claim 1, wherein the processing device executes a program on a remote device (page 4, lines 21-30).

10. Claims 5, 6, 8-10, 15, 16, 19-24, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergato in view of (US 6,421,653) May.

As per claims 5 and 20 The system according to claim 1, Bergato failed to teach, wherein the storage device includes a database storing data which is related to the at least one tender.

May discloses, wherein the storage device includes a database storing data which is related to the at least one tender (col. 13, lines 23-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the storage device include a database storing data which is related to the at least one tender and to modify in Bergato because such a modification would allow Bergato to have a storage device that includes a database for various data relating to diamonds to be offered for sale as well as other data concerning those diamonds.

As per claims 6 and 21 The system according to claim 5, Bergato failed to teach, wherein the database is a relational database. May teaches, wherein the database is a relational database. (col. 13, lines 32-34 and fig. 2 (66)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the database to be a relational database and to modify in Bergato because such a modification would allow Bergato to store information in tables- rows and columns of data- and to conduct searches using data in the specified columns of one table to find additional data in another table which is old and well known in the database art.

As per claims 8 and 22, the system according to claim 1, Bergato teaches, wherein the processing device: receives the data, analyzes the data, and transmits the information to a further processing device, wherein the information is transmitted in response to the received data (page 16, line 13 – page 17, line 21 and page 22, lines 2-6).

As per claims 9, 15, 23, and 28, the system according to claim 1, Bergato teaches, wherein the processing device at least one of transmits and receives the information electronically via the Internet (page 15, lines 17-25).

As per claims 10, 16, 24, and 29, the system according to claim 1, May failed to teach, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices.

May teaches, wherein the processing device at least one of transmits and receives information electronically via a network of further processing devices (col. 13, lines 35-65, col. 15, lines 2-22, and col. 23, line 56 –col. 24, line 53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the processing device to be at least one of transmits and receives information electronically via a network of further processing devices and to modify in Bergato because such a modification would allow Bergato to have a processor that runs Microsoft web browser Internet Explorer and a dial-up networking and display setting for receiving and transmitting data.

As per claim 19, Bergato teaches, wherein the processing device executes a program on a remote device (page 4, lines 21-30).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

David (US 6,493,683) disclosed a computer-based auction and commodities having a variable value.



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Bay, Jr. (US 5,347,452) disclosed buying and selling commodities that exhibit different characteristics.

### **Inquiries**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert

November 26, 2004